

Attorney Docket No. P13329-US3
Customer Number 27045

REMARKS/ARGUMENTS

1.) Claim Amendments

The Applicant has amended claims 1, 13, and 21. Claims 9-10, 14-15, 17, and 25 have been canceled without prejudice. Accordingly, claims 1-8, 11-13, 16, and 18-24 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

Claims have either been cancelled or amended to incorporate the elements of existing dependent claims. Consequently, the amendments do not raise new issues that would require a further search or substantial consideration by the Examiner.

2.) Examiner Objections - Abstract

The Examiner objected to the abstract because of an informality. The Applicant thanks the Examiner for his careful review of the abstract. In response, the Applicant has modified the abstract as suggested by the Examiner. The Examiner's consideration of the amendment to the abstract is respectfully requested.

3.) Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claims 1-13, 15 and 17-25 under 35 U.S.C. § 103(a) as being unpatentable over McConnell, et al. (WO 00/469963). As noted above, claims have either been cancelled or amended to incorporate the elements of existing dependent claims. Consequently, the amendments do not raise new issues that would require a further search or substantial consideration by the Examiner. The Examiner's consideration of the amended claims is respectfully requested.

Specifically, the limitations of claims 9 and 10, have been incorporated into claim 1. The limitations of claim 20 have been incorporated into claim 13 and the limitations of claim 25 has been incorporated into claim 21. These amendments were made solely to expedite allowance of this application. To the extent that the Examiner's rejections to claims 9, 10, 20, and 25 are still applicable, the Applicant respectfully traverses these rejections.

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For instance, amended claim 1 states:

1. A method for associating a MSISDN with a temporary IP address within a service network, comprising the steps of:
transmitting a start packet to a database associated with the service network, the start packet including a MSISDN and a temporary IP address of the mobile terminal; and
storing the MSISDN and the temporary IP address in the database wherein the MSISDN and the temporary IP address are associated with each other responsive to the start packet;
receiving a request for a service from the mobile terminal at a third server within the service network;
determining an MSISDN of the mobile terminal by accessing the database using the temporary IP address of the mobile terminal;
placing the determined MSISDN into an http header for applications within the service network using http; and
transmitting the http header to the application within the service network using http with a data packet.

McConnell does not teach the steps of "placing the determined MSISDN into an http header; and transmitting the http header to the application within the service network using http with a data packet." Amended claim 1, on the other hand, explicitly states that the MSISDN is placed into an HTTP header. McConnell appears to teach that the MSISDN is sent to the original server via the origin server's client. Thus, it appears that McConnell teaches that the mobile stations places the MSISDN in the WAP header and sends it to the origin server. The WAP gateway, in turn, removes the MSISDN when the number is not sent to the origin server. Thus, claim 1, as amended, contains elements not taught nor suggested by McConnell.

Furthermore, the Examiner admits that claim McConnell does not teach all of the elements of the original claim 1. In support the §103 rejection, the Examiner has supplied the missing elements of claim 1 by stating that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included associating with a service network to the invention of McConnell et. al because a service network is a network that hosts a number of services for users. The Applicant respectfully traverses this assertion. As provided in MPEP § 2143, "[t]o establish a prima facie case of obviousness, the prior art reference (or references when combined)

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must teach or suggest all the claim limitations." Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." It is submitted that the Office action does not factually support a prima facie case of obviousness for claim 1 based on McConnell.

If the Examiner is asserting that the missing limitations of McConnell are obvious in light of what is "well known in the art" then, as permitted under MPEP § 2144.03, the Applicant requests that the Examiner cite a reference in support of his position for each rejected claim.

Alternatively, if the Examiner is relying on his personal knowledge as the basis for these assertions, the Applicant respectfully objects to the Examiner's use of official notice. Under MPEP § 2144.03, official notice may only be taken of "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art." When a rejection is based on facts within the personal knowledge of the Examiner, the facts must be as specific as possible, and the reference must be supported, when called for by the applicant, by an affidavit of the Examiner, which may be subject to explanation by the Applicant. See also 37 CFR 1.104(d)(2). Pursuant to 37 CFR 1.104(d)(2), the Applicant respectfully requests the Examiner provide such supporting facts and evidence in the form of an affidavit, so that, if necessary, the Applicant may have an opportunity to explain the reference.

In either case, the Applicant respectfully requests that the Examiner provide a reference which can be examined and explained by the Applicant. Otherwise, the Applicant respectfully asserts that amended claim 1 is in a condition for allowance.

Claims 2-8 and 11-12 depend from amended claim 1 and recite further limitations in combination with the novel elements of claim 1. Therefore, the allowance of claims 2-8 and 11-12 is respectfully requested.

Amended claim 13 states:

13. A system comprising:
 - a mobile switching center of a wireless network;
 - a first server associated with a wireless network for generating a start packet responsive to an access request from a mobile terminal, the

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start packet containing a MSISDN provided by the mobile terminal and an IP address assigned to the mobile terminal by the first server, wherein the first server is located within a mobile switching center of the wireless network;

a database associated with a service network having storage locations for a plurality of MSISDNs and associated assigned IP addresses; and

a second server associated with the service network for retrieving the stored MSISDN the database responsive to an IP address in a service request from the mobile terminal, and

a RADIUS accounting server within the service network and associated with the database.

Amended claim 13 now contains the limitations of former claims 14 and 17. The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over McConnell in view of Joong (US 6,549,776). To the extent that the Examiner's rejections to claim 14 is still applicable, the Applicant respectfully traverses this rejection.

First, the RADIUS accounting server in this claim is associated with a database which is "a database associated with a service network having storage locations for a plurality of MSISDNs and associated assigned IP addresses." McConnell does not appear to teach a RADIUS accounting server associated with a database having "storage locations for a plurality of MSISDNs and associated assigned IP addresses."

Second, the Examiner has cited Joong in combination with McConnell. The Applicant respectfully traverses this rejection because Joong was commonly owned at the time this invention was made.

Statement of Common Ownership

This present application and Joong were, at the time of the invention of the present application, owned by, or subject to an obligation of assignment to Telefonaktiebolaget L M Ericsson, a Swedish corporation.

This present application was filed after November 29, 1999. Accordingly, Applicant asserts that the subject matter of Joong is disqualified as prior art under 35 U.S.C. §103(c).

Because Joong is disqualified as prior art, a 103 rejection is not proper. Therefore, the allowance of amended claim 13 is respectfully requested.

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Claims 18-20 depend from amended claim 13 and recite further limitations in combination with the novel elements of claim 13. Therefore, the allowance of claims 18-20 is respectfully requested.

The Examiner rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over McConnell in view of Forslow (US 6,608,832). The Applicant respectfully traverses this rejection because Forslow was also commonly owned at the time this invention was made.

Statement of Common Ownership

This present application and Forslow were, at the time of the invention of the present application, owned by, or subject to an obligation of assignment to Telefonaktiebolaget L M Ericsson, a Swedish corporation.

This present application was filed after November 29, 1999. Accordingly, Applicant asserts that the subject matter of Forslow is disqualified as prior art under 35 U.S.C. §103(c).

Because Forslow is disqualified as prior art, a 103 rejection is not proper. Therefore, the allowance of amended claim 16 is respectfully requested.

The Examiner rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Mademann (US 6,185,196). As amended, claim 1 teaches elements which are clearly not taught by Mademann. Furthermore, Mademann appears to teach the concept of TMSI = temporary mobile subscriber identity. This term is defined in section 2 of 3GPP's Tech Spec 23.003. A review of this work indicates that TMSI is not related to IP-addresses. Although an MSISDN is used in Mademann, it is not used in combination with an IP-address as clearly stated in claim 1.

Furthermore, the Examiner admits that Mademann does not teach all of the elements of former claim 1. In support the §103 rejection, the Examiner has supplied the missing elements of claim 1 by stating that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included to the invention transmitting a start packet and the start packet including a MSISDN because the joint transmission of data packets and signaling information is disclosed in (col. 4

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lines 37-45). The Applicant respectfully traverses this assertion. As provided in MPEP § 2143, "[t]o establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." It is submitted that the Office action does not factually support a prima facie case of obviousness for claim 1 based on Mademann.

If the Examiner is asserting that the missing limitations of Mademann are obvious in light of what is "well known in the art" then, as permitted under MPEP § 2144.03, the Applicant requests that the Examiner cite a reference in support of his position for each rejected claim.

Alternatively, if the Examiner is relying on his personal knowledge as the basis for these assertions, the Applicant respectfully objects to the Examiner's use of official notice. Under MPEP § 2144.03, official notice may only be taken of "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art." When a rejection is based on facts within the personal knowledge of the Examiner, the facts must be as specific as possible, and the reference must be supported, when called for by the applicant, by an affidavit of the Examiner, which may be subject to explanation by the Applicant. See also 37 CFR 1.104(d)(2). Pursuant to 37 CFR 1.104(d)(2), the Applicant respectfully requests the Examiner provide such supporting facts and evidence in the form of an affidavit, so that, if necessary, the Applicant may explain the reference.

In either case, the Applicant respectfully requests that the Examiner provide a reference which can be examined and explained by the Applicant. Otherwise, the Applicant respectfully asserts that amended claim 1 is in a condition for allowance.

CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore,

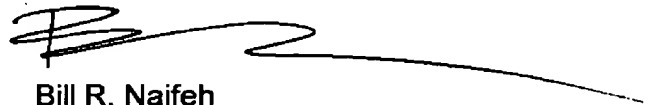
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respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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